UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIGERU YANO, MINDIAW WANG
and TAROH ICHIKAWA

Appeal No. 2005-1824
Application No. 09/913,725

HEARD: September 14, 2005

Before KIMLIN, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

Upon a careful review of the record in this appeal, we determine that this application is not in condition for a decision at this time. Accordingly, pursuant to our authority under 37 CFR § 41.50(a)(1)(effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)), we remand this application to the jurisdiction of the examiner for action consistent with our remarks below.

In the answer, the examiner maintains a § 103(a) rejection of appealed claims 1, 2 and 5-7 over Japanese Patent Publication No. 11158305, published June 15, 1999 without making of record and referring to a complete and accurate verified full English language translation of the Japanese language patent publication. Rather, the examiner makes reference to computer (machine) translation of the text of the Japanese document without furnishing a complete and accurate readable, non-machine, verified translation of that relied upon document. Indeed, at the top of page 1 of the Japan Patent Office translation, a disclaimer as to the accuracy of the translation is presented with the further liability disclaimer that the "Japan Patent Office is not responsible for any damage caused by the use of this translation." A review of the translation reveals that many sentences and phrases employed therein are virtually undecipherable.

Nor has the examiner referred to any other English language document of record that would serve as an accurate and complete translation of the published Japanese patent application.

While the ultimate question of obviousness under 35 U.S.C. § 103 is one of law, the question can only be answered

after the requisite factual findings have been made. Such factual findings can not be made from an unreliable translation. Obtaining and considering an accurate, and verified English language translation of the full text of the relied upon foreign language document is necessary in furnishing reliable evidence of the factual basis for making the ultimate determination of patentability.

Accordingly, this application is remanded to the examiner for the purpose of clarifying the examiner's rejection in light of any complete and accurate verified English language translation of the relied upon Japanese document that is secured and ultimately made of record and a copy of the translated document should be forwarded to appellants. The examiner should fully explain how the relied upon publication is being applied by referring to the verified accurate English language translation that is obtained by page and line in any rejection maintained in a supplemental examiner's answer that may be ultimately prepared in response to this remand.

Moreover, should the examiner issue a supplemental answer, the examiner should fully respond to the arguments presented in the reply brief.

CONCLUSION

For the reasons outlined above, this application is remanded to the jurisdiction of the examiner. Pursuant to the provisions of 37 CFR § 41.50(a)(2) (effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)), appellants are required to timely respond to any supplemental examiner's answer that may be issued in response to this remand. As stated in this rule, appellants must exercise one of the two following two options to avoid sua sponte dismissal of the appeal as to the claims involved in the remand: (I) request that prosecution be reopened before the examiner by filing a reply under Rule 111 with or without amendment or evidence or (ii) request that the appeal be maintained by filing a reply brief as provided in 37 CFR § 41.41.

This application, by virtue of its "special" status, requires an immediate action; see MPEP § 708.01 (D)(8th ed., Rev. 2, May 2004, p. 700-126).

REMANDED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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PETER F. KRATZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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)
JEFFREY T. SMITH)
Administrative Patent Judge)

PFK/sld

ROBERT G. MUKAI
BURNS DOANE SWECKER & MATHIS
P.O. BOX 1404
ALEXANDRIA, VA 22313-1404

APPEAL NO. - JUDGE KRATZ
APPLICATION NO.

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DECISION: **ED**

Prepared By:

DRAFT TYPED: 19 Sep 05

FINAL TYPED: